PATENT
Attorney Docket No. 05725.1009-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
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Gilles RUBINSTENN et al.	)	Group Art Unit: 3628
	)	
Application No.: 10/024,351	)	Examiner: Igor N. Borissov
	)	
Filed: December 21, 2001	)	
	)	
For: CUSTOMIZED BEAUTY TRACKING KIT	)	Confirmation No.: 4841
	)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

SURREPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Surreply Brief responsive to the Supplemental Examiner's Answer mailed on June 29, 2010. Appellant respectfully submits the following remarks.

I. REMARKS

In the Supplemental Examiner's Answer dated June 29, 2010, the Examiner set forth new grounds of rejection not previously on record. Appellant respectfully submits the following remarks in response to the Examiner's new grounds of rejection.

a. The rejection of claims 11, 13, 14, and 17 under 35 U.S.C. § 112, second paragraph, should be reversed because the specification sets forth adequate description of the means performing the claimed functions.

The Examiner rejected claims 11, 13, 14, and 17 under 35 U.S.C. § 112, second paragraph, because "[t]he Specification does not set forth any software instructions or algorithms for performing" several means-plus-function limitations recited in these claims. (Supplemental Examiner's Answer (hereinafter "Answer") at 6.) Appellant respectfully disagrees.

The Examiner notes that, according to *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333 (Fed. Cir. 2008), for a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. § 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer. (Answer at 5-6.) The Examiner also notes that, in *Aristocrat*, the Federal Circuit further held that "[t]he written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function." (Answer at 6, (citing *Aristocrat* at 1338.))

The Examiner alleges that Appellant's specification does not satisfy the requirements of *Aristocrat* because "[t]he Specification does not set forth any software instructions or algorithms" corresponding with the "means for selecting a set of personal

questions" and the "means for . . . selecting . . . at least one customized set of testing material," recited in claim 11, the "means for ascertaining quantitative information," recited in claim 13, the "means for . . . recommending at least one beauty product," recited in claim 14, and the "means for maintaining an inventory," recited in claim 17. (Answer at 6.) Each of these claim recitations is addressed below in a respective subsection.

1. **"Means for selecting a set of personal questions"**

Disclosure relating to the process of selecting a set of personal questions for which a means is recited in claim 11, is discussed in the specification at, for example, paragraph [054]. Paragraph [054] provides an exemplary algorithm by which a set of personal questions may be selected. Specifically, paragraph [054] explains that

> [f]or example, if the results of the physical test indicate an oily skin condition, subsequent questions regarding a dry skin condition may be omitted, and additional questions regarding the oily skin condition may be presented.

In addition, paragraph [062] explains that

> [f]or example, the first question subset may include one or more questions regarding aging. If a subject responds that no signs of aging are present, then the subject, in one embodiment, may not receive further tests or inquiries regarding skin elasticity, wrinkles, or age spots. However, if a subject responds affirmatively to aging, further tests and/or questions may be presented to the subject regarding aging.

(Emphasis added.)

In addition to these exemplary algorithms, the specification sets forth many additional external body conditions besides skin dryness and signs of aging. The specification sets forth, in paragraph [026], an extensive listing of external body conditions about which the questions in the system may seek information, including skin

texture, exfoliation, skin or hair color, hair thickness, etc. The specification, at paragraph [055], also sets forth an extensive list of body condition parameters for which information may be collected (e.g., via image capture), such as number of wrinkles or moles, skin shininess, hydration, redness, baldness, etc.

Further, the specification describes an exemplary embodiment wherein the process of selecting a set of personal questions includes comparing subject provided information with information stored in a database. For example, paragraph [058] describes a method wherein

> [u]sing the data base, the algorithm may compare subject provided information with the stored correlation data to narrow the plurality of questions to a subset of questions. For example, the data base may contain information reflecting a high likelihood of acne or blemishes with individuals who respond affirmatively to an oily skin condition. Thus, when a subject responds affirmatively to such a condition, the algorithm may compare the subject's response to information in the data base and, based on that comparison, present further questions regarding blemishes or acne, while suppressing questions about dry skin.

(Emphasis added.) Moreover, paragraph [058] also points out that

> [s]imilar concepts are described in a concurrently filed application entitled, "Cosmetic Affinity Indexing," (Attorney Docket No. 05725.0986), the disclosure of which is incorporated herein by reference.

Additionally, the specification also describes the types of processing which may be employed by the algorithm. For example, paragraph [054] specifies that

> [t]he algorithm may employ artificial intelligence, a decision tree, mathematics, or any logic or intelligence based algorithm for selecting the appropriate subset of questions.

Further, the specification sets forth, in paragraphs [0114]-[0116], exemplary forms of artificial intelligence that may be implemented by the disclosed system.

In addition, paragraph [0107] specifies that recited actions such as "selecting," as used in the present application, "are inclusive of direct and indirect actions." Paragraph [0107] provides that examples of indirect activity include "sending signals, providing software, providing instructions, cooperating with an entity to have the entity perform the action, outsourcing direct or indirect actions, or serving in any way as an accessory to the specified action." Therefore, in addition to the algorithms discussed above, "means for selecting" may further correspond to mechanisms and algorithms in accordance with the preceding examples of indirect activity.

Appellant respectfully submits that, because the afore-mentioned portions of the specification include extensive examples and explanations of the algorithms by which the disclosed system may be implemented to "select[] a set of personal questions . . . ," the specification provides adequate corresponding "structure" for the presently claimed "means for selecting" limitation, in accordance with *Aristocrat*.

2. "Means for . . . selecting . . . at least one customized set of testing material"

The specification has disclosure relating to the process of selecting at least one customized set of testing materials, which is similar to the disclosure discussed above regarding selection of a set of personal questions. Appellant's specification describes exemplary algorithms for the process of selecting at least one customized set of testing materials in paragraphs [064]-[066], as follows:

> [064] Consistent with the invention, a method may include identifying, as a function of the first response set, at least one physical self-test to be conducted by the subject, as shown at step 508 of Figure 5. Identifying the at least one physical self-test may be accomplished using a selection algorithm, the selection algorithm evaluating the first response set to select at least one physical test.

> [065] For example, if the subject indicates a dry skin condition in the first response set, the selection algorithm may select test materials, such as d-squame disks, that determine a level of skin dryness, rather than test materials, such as sebutape, that determine a level of skin oiliness.
>
> [066] Similarly, if a subject responds that signs of aging are present, the subject may receive one or more self-tests for measuring skin elasticity, wrinkles, moisture levels, skin fattiness, and so forth, in response to a positive indication of aging . . . .

(Emphasis added.)

Further, the specification describes an exemplary embodiment wherein the process of selecting a customized set of testing material includes comparing subject provided information with information stored in a database. Such a comparison is discussed, for example, in paragraph [068]. This exemplary method is further discussed in paragraph [069] as follows:

> A customer who indicated an aging condition may receive an A-type package 602, having skin elasticity test materials, while a customer with an oily skin condition may receive a B-type package 604, having sebutape test materials. The package may contain anyone or more of the test materials described above in reference to the first embodiment. In this way, customized test kits may be sent to consumers.

In addition to the exemplary algorithms discussed above, the specification also lists numerous types of testing materials from which the selection of a customized set of testing materials may be made. For example, paragraphs [042]-[043] discuss Sebutape, d-squame discs, corneodisque indicators, and pH indicators, ion detectors, mineral detectors, organic detectors, hormone charts, color charts, etc. Further, paragraph [044] notes that "[e]xamples of other test materials are disclosed in provisional application No. 60/331,003, filed on November 6, 2001, . . . the disclosure of which is incorporated herein by reference."

Additionally, the specification also describes the types of mechanisms which may be employed by the testing material selecting algorithm. For example, paragraph [067] specifies that "the selection algorithm for identifying the physical selftest may employ artificial intelligence, a decision tree, or any other type of logic for identifying the physical self-test."

Also, in addition to the algorithms discussed above, "means for selecting" may further correspond to mechanisms and algorithms in accordance with the disclosed examples of indirect activity, as explained above with regard to the recitation of "means for selecting a set of personal questions."

Appellant respectfully submits that, because the afore-mentioned portions of the specification include extensive examples and explanations of the algorithms by which the disclosed system may be implemented to "select[] a customized set of testing material . . . ," the specification provides adequate corresponding "structure" for this claimed "means for selecting" limitation, in accordance with *Aristocrat*. Accordingly, since both of the "means for selecting" limitations alleged to be problematic by the Examiner under § 112, second paragraph, are adequately supported in the specification, Appellant respectfully submits that the new rejection of claim 11 under § 112, second paragraph, should be reversed.

3. "Means for ascertaining quantitative information by collecting data derived from use of the testing material on the subject"

Appellant submits that the specification sets forth corresponding structure for the claimed "means for ascertaining quantitative information by collecting data from use of the testing material on the subject" limitation recited in claim 13. Paragraph [083] explains that

> [c]onsistent with the invention, the method may include ascertaining the desired quantitative information by collecting data derived from use of the testing material on the subject. This is shown in step 710 of Figure 7. The data derived from use of the testing materials may be provided electronically, physically, or telephonically, as described in detail above with reference to the first embodiment.

As recited in paragraph [083], as well as in claim 13 itself, the ascertaining is performed "by collecting data." Numerous different types of data are envisioned to be collected (see paragraphs [045], [046], and [083]) and, therefore, there are disclosed various ways by which the data may be provided and received. For example, paragraph [048] indicates that

> information may be provided by the subject electronically or verbally through a microphone connected to the subject's computer to interactive software running on the subject's computer or at a host website. Alternatively, the information may be mailed in hard-copy form, transmitted by facsimile, e-mailed, or telephonically provided to a designated location.

Accordingly, since the types of data and the format by which the data is submitted may take such a wide range of forms, the "means for ascertaining quantitative information" may also take a variety of forms. Appellant respectfully submits that a skilled artisan would readily recognize the appropriate means by which data of the various disclosed types and in the various disclosed forms may be collected and, thereby, quantitative information ascertained.

For at least these reasons, Appellant respectfully submits that the recited "means for ascertaining" in claim 13 is adequately supported in the specification, and thus, the new rejection of claim 13 under § 112, second paragraph, should be reversed.

4. "Means for . . . recommending at least one beauty product"

Paragraph [084] of the specification provides that

> [c]onsistent with the invention, the method also may include recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information, as depicted at step 712 in Figure 7. The beauty product may be selected using a selection algorithm, described above in reference to the first and second embodiments. The selection algorithm may employ artificial intelligence, a decision tree, or any other logic for selecting a beauty product. The selection algorithm also may comprise maintaining in a data base beauty information on a plurality of individuals and selecting the beauty product by comparing the test results with information in the data base.

(Emphasis added.) Appellant notes that, according to paragraph [084], the "means for . . . recommending at least one beauty product" may include a selection algorithm described in reference to the description regarding the processes of selection of questions and the selection of testing materials.

The algorithms for these selection processes are discussed hereinabove and, accordingly, for at least the same reasons discussed above with regard to the other selection processes, Appellant respectfully submits that the corresponding structure for the recitation of a "means for . . . recommending at least one beauty product" in claim 14 is adequately set forth in the specification. Accordingly, Appellant submits the § 112, second paragraph, rejection of claim 14 should be reversed.

5. "Means for maintaining an inventory"

Paragraph [082] of Appellant's specification explains that

> the customized kit may be provided by maintaining an inventory of a plurality of differing groups of test kits, each group containing a combination of tests different from a combination in another group. This embodiment is shown in Fig. 6, wherein groups 602, 604, and 606 contain different combination of tests. Thus, providing the subject with a customized test kit may include selecting and shipping an appropriate test kit 602, 604, or 606 from a group maintained in inventory.

In addition, paragraph [069] indicates that the combinations of testing materials may be maintained by grouping together testing materials related to the same or similar external body conditions. For instance, paragraph [069] describes two exemplary types of groups as follows.

> A customer who indicated an aging condition may receive an A-type package 602, having skin elasticity test materials, while a customer with an oily skin condition may receive a B-type package 604, having sebutape test materials.

Therefore, Appellant respectfully submits that it is clear to a skilled artisan the type of algorithms used for "maintaining an inventory of a plurality of differing groups of customized sets of testing material," as recited in claim 17.

In addition, paragraph [0106] provides that

> [f]orms of the word "maintain" are used broadly to include gathering, storing, accessing, providing access to, or making something available for access, either directly or indirectly. For example, those who maintain information include entities who provide a link to a site of a third party where the information is stored.

Accordingly, "means for maintaining an inventory" may include more than mere software algorithms.

In view of the foregoing, Appellant respectfully submits that an adequate corresponding description is provided in the specification for the recited "means for maintaining an inventory," recited in claim 17. Therefore, Appellant submits that the new rejection of claim 17 under § 112, second paragraph, should be reversed.

II. CONCLUSION

In view of the remarks above and the remarks set forth in the Appeal Brief filed February 10, 2009, as well as those set forth in the Reply Brief filed May 18, 2009,

Appellant respectfully submits that all of the claim rejections, including the rejections based on new grounds set forth in the Supplemental Examiner's Answer of June 29, 2010, should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Surreply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 26, 2010

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